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EXAMINER

PHUONG, DAI

ART UNIT

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	Application No. 10/612,970	Applicant(s) HOLMES, DAVID W.	
	Examiner Dai A. Phuong	Art Unit 2617	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 05 April 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-32, 36 and 38-63 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-32, 36 and 38-63 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 07 July 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                 | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                        | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date. _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Response to Arguments*

1. Applicant's arguments with respect to claims have been considered but are moot in view of the new ground(s) of rejection. Claims 33-35 and 37-38 have been canceled in response filed on 01/11/2007. Claims 1-32, 36 and 38-63 are currently pending.

### *Claim Rejections - 35 USC § 101*

2. Claims 52-55 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claims 52-55 lack the proper preamble necessary for a statutory computer program product claim. See MPEP 2100 for guidance on computer related inventions.

The Examiner suggests a preamble as follows:

1. "computer readable medium" encoded with \_\_\_\_\_
  - [a] "a computer program"
  - [b] "software"
  - [c] "computer executable instructions"
  - [d] "instructions capable of being executed by a computer"
2. "a computer readable medium" \_\_\_\_\_ "computer program"
  - [a] storing a
  - [b] embodied with a
  - [c] encoded with a
  - [d] having a stored
  - [e] having an encoded

### *Claim Rejections - 35 USC § 103*

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person

having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-2, 8-19, 21-24, 28-31, 33, 36, 38, 42-46 and 50-57 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lunsford et al. (Pub. No: 2002/0065041) in view of Kubo et al. (Pub. No: 20040067784).

Regarding claim 1, Lunsford et al. disclose a method comprising:

generating a dialing request at a remote control device 12 based on an operation of a dedicated control of the remote control device 12, the dedicated control dedicated to generating the dialing request to transmit a binary-valued dialing signal to a mobile communication device 14 (fig. 1, [0057] to [0059]. Specifically, Lunsford et al. disclose the PID 12 can accept input from a user, such as selecting a specific contact using contact management program 101, and automatically dial a telephone number stored in its memory via a wireless communication with telephone 14. The wireless link 20 enables applications executed on PID 12 (e.g., address book program 109) to access the telephone 14 and automatically dial the number stored in the application (e.g., within memory 40). The wireless link 20 enables an application executing on PID 12 to access telephone 14, communicate the desired telephone number, and control telephone 14 to dial the number and established the telephone call); and

transmitting the dialing signal from the remote control device 12 toward the mobile communication device 14 based on the dialing request, the dialing signal instructing the mobile communication device to access a network-based communication service (fig. 1, [0065] to [0067]. Specifically, Lunsford et al. disclose a wireless link 20 has been established between the PID 12 and the telephone 14. After establishing, the user can select the desired

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individual/organization to contact. From the list, the user selects the desired contact. After selection of the desired contact, the user verifies the specific number to dial. The user confirms the wireless autodial to the specific number. The PID 12 is using a wireless communication link 20 to transfers the specific number to telephone 14. Subsequently, PID 12 controls telephone 14 to dial the specific number and complete the telephone communication. Thus, the user's handheld PID 12 can automatically instruct a cellphone 14 to dial a telephone number stored in the PID's memory. It should be noted that in order to dial the telephone number stored in the PID's memory, the PID 12 automatically instructs the telephone 14 communicates with a network-base communication service and/or a base station, in order to establish a connection between the PID 12 and other party).

However, Lunsford et al. do not disclose generating a dialing request at a remote control device based on an operation of a user interface consisting of a single dedicated control of the remote control device.

In the same field of endeavor, Kubo et al. disclose generating a dialing request at a remote control device based on an operation of a user interface consisting of a single dedicated control of the remote control device (fig. 1a to fig. 1c, [0044] to [0046]).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the personal information device of Lunsford et al. by specifically including generating a dialing request at a remote control device based on an operation of a user interface consisting of a single dedicated control of the remote control device, as taught by Kubo et al., the motivation being in order to easily make contact with a small number of specific distant parties, for example between children and their guardians, between children and their

school or between children and nearby relatives such as their grandparents. For elderly people also, it is convenient via portable telephone terminal to be able to easily make contact with a small number of specific distant parties.

Regarding claims 2, the combination of Lunsford et al. and Kubo et al. disclose all the limitations in claims 1. Further, Lunsford et al. disclose the method wherein the dialing request is initiated by a user manipulation of an access button of the remote device ([0057] to [0059] and [0064] to [0067]).

Regarding claim 24, this claim is rejected for the same reason as set forth in claim 2.

Regarding claim 45, this claim is rejected for the same reason as set forth in claim 2.

Regarding claim 53, this claim is rejected for the same reason as set forth in claim 2.

Regarding claim 55, this claim is rejected for the same reason as set forth in claim 2.

Regarding claim 57, this claim is rejected for the same reason as set forth in claim 2.

Regarding claims 8 and 42, the combination of Lunsford et al. and Kubo et al. disclose all the limitations in claims 1 and 36 respectively. Further, Lunsford et al. disclose the method wherein the dialing signal includes a telephone number associated with the network-based communication service, the method further including retrieving the telephone number from a memory of the remote control device ([0026], [0057] to [0059] and [0064] to [0067]).

Regarding claim 9, the combination of Lunsford et al. and Kubo et al. disclose all the limitations in claim 8. Further, Lunsford et al. disclose the method further including storing the telephone number to the memory before generating the dialing request ([0026], [0057] to [0059] and [0064] to [0067]).

Regarding claim 10, the combination of Lunsford et al. and Kubo et al. disclose all the limitations in claim 9. Further, Lunsford et al. disclose the method further including storing the telephone number to the memory based on input from a user of the mobile communication device ([0026], [0057] to [0059] and [0064] to [0067]).

Regarding claim 11, the combination of Lunsford et al. and Kubo et al. disclose all the limitations in claim 9. Further, Lunsford et al. disclose the method further including storing the telephone number to the memory based on input from a provider of the network-based communication service ([0060] to [0061]).

Regarding claim 12, the combination of Lunsford et al. and Kubo et al. disclose all the limitations in claim 9. Further, Lunsford et al. disclose the method wherein storage of the telephone number to the memory is initiated by the provider of the network-based communication service ([0060] to [0061]).

Regarding claim 13, the combination of Lunsford et al. and Kubo et al. disclose all the limitations in claim 9. Further, Lunsford et al. disclose the method wherein storage of the telephone number to the memory is initiated by a user of the remote control device ([0060] to [0061]).

Regarding claim 14, the combination of Lunsford et al. and Kubo et al. disclose all the limitations in claim 9. Further, Lunsford et al. disclose the method further including storing the telephone number to the memory based on input from a manufacturer of the remote control device ([0060] to [0061]).

Regarding claim 15, the combination of Lunsford et al. and Kubo et al. disclose all the limitations in claim 9. Further, Lunsford et al. disclose the method further including verifying authorization to write to the memory before storing the telephone number ([0061]).

Regarding claims 16 and 28, the combination of Lunsford et al. and Kubo et al. disclose all the limitations in claims 1 and 23 respectively. Further, Lunsford et al. disclose the method wherein the transmitting of the dialing signal occurs over a wireless connection with the mobile communication device ([0029] to [0036] and [0045] to [0052]).

Regarding claims 17 and 29, the combination of Lunsford et al. and Kubo et al. disclose all the limitations in claims 16 and 28 respectively. Further, Lunsford et al. disclose the method wherein the wireless connection is a radio frequency (RF) connection ([0029] to [0036] and [0045] to [0052]).

Regarding claims 18, 30 and 43, the combination of Lunsford et al. and Kubo et al. disclose all the limitations in claims 17, 29 and 36 respectively. Further, Lunsford et al. disclose the method wherein the transmitting of the dialing signal occurs in accordance with a Bluetooth standard ([0029] to [0036] and [0045] to [0052]).

Regarding claims 19 and 31, the combination of Lunsford et al. and Kubo et al. disclose all the limitations in claims 17 and 28 respectively. Further, Lunsford et al. disclose the method wherein the wireless connection is an infrared (IR) connection ([0029] to [0036] and [0045] to [0052]).

Regarding claims 21 and 50, the combination of Lunsford et al. and Kubo et al. disclose all the limitations in claims 1 and 44 respectively. Further, Lunsford et al. disclose the method



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wherein the mobile communication device is a personal digital assistant (PDA) configured for wireless communication ([0026] to [0030]).

Regarding claims 22 and 51, the combination of Lunsford et al. and Kubo et al. disclose all the limitations in claims 1 and 44 respectively. Further, Lunsford et al. disclose the method wherein the mobile communication device is a wireless phone ([0026] to [0030]).

Regarding claim 23, this claim is rejected for the same reason as set forth in claim 1.

Regarding claim 36, this claim is rejected for the same reason as set forth in claim 1.

Regarding claim 38, the combination of Lunsford et al. and Kubo et al. disclose all the limitations in claim 36. Further, Lunsford et al. disclose the remote control device wherein the user interface has no buttons other than the access button ([0045] to [0050] and [0057] to [0059]).

Regarding claim 44, this claim is rejected for the same reason as set forth in claim 1.

Regarding claim 46, the combination of Lunsford et al. and Kubo et al. disclose all the limitations in claim 44. Further, Lunsford et al. disclose the mobile communication device further including a memory to store a telephone number associated with the network-based communication service, the wireless transceiver to use the telephone number to access the network-based communication service in response to the dialing signal ([0056] to [0059] and [0064] to [0067]).

Regarding claim 52, this claim is rejected for the same reason as set forth in claim 1.

Regarding claim 54, this claim is rejected for the same reason as set forth in claim 1.

Regarding claim 56, this claim is rejected for the same reason as set forth in claim 1.

5. Claims 3-5, 25-27, 34, 39-41, 47-49 and 58-61 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lunsford et al. (Pub. No: 2002/0065041) in view of Kubo et al. (Pub. No: 20040067784) and further in view of Holt et al. (Pub. No: 20050113074).

Regarding claims 3, 25, 39, 47 and 58, the combination of Lunsford et al. and Kubo et al. disclose all the limitations in claims 1, 23, 36, 44 and 56 respectively. However, the combination of Lunsford et al. and Kubo et al. do not disclose the method wherein the network-based communication service is a voice information service, the voice information service enabling a user to use information retrieval at a network server.

In the same field of endeavor, Holt et al. disclose the method wherein the voice-controlled service is a voice information service, the voice information service enabling a user to use information retrieval at a network server ([0060] to [0061]).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the personal information device of the combination of Lunsford et al. and Kubo et al. by specifically including Holt et al. disclose the method wherein the voice-controlled service is a voice information service, the voice information service enabling a user to use information retrieval at a network server, as taught by Holt et al., the motivation being in order to reduce network costs and can make a speech-recognition and control in communication networks more affordable. Additionally, there is another advantage that the loss of power or receipt of a physical impact of a mobile station contemplated by the present invention does not

risk the loss of data as with conventional mobile stations. Moreover, the purchase of a new mobile station does not require the user to reprogram data as with conventional mobile stations.

Regarding claims 4, 26, 34, 40, 48 and 59, the combination of Lunsford et al. and Kubo et al. disclose all the limitations in claim 1, 23, 36, 44 and 56 respectively. However, the combination of Lunsford et al. and Kubo et al. do not disclose the method wherein the network-based communication service is a voice dialing service, the voice dialing service enabling a user to use number dialing at a network server.

In the same field of endeavor, Holt et al. disclose the method wherein the network-based communication service is a voice dialing service, the voice dialing service enabling a user to use number dialing at a network server ([0060] to [0061]).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the personal information device of the combination of Lunsford et al. and Kubo et al. by specifically including the network-based communication service is a voice dialing service, the voice dialing service enabling a user to use number dialing at a network server, as taught by Holt et al., the motivation being in order to reduce network costs and can make a speech-recognition and control in communication networks more affordable. Additionally, there is another advantage that the loss of power or receipt of a physical impact of a mobile station contemplated by the present invention does not risk the loss of data as with conventional mobile stations. Moreover, the purchase of a new mobile station does not require the user to reprogram data as with conventional mobile stations.

Regarding claims 5, 27, 41, 49, 60 and 61, the combination of Lunsford et al. and Kubo et al. disclose all the limitations in claims 1, 23, 33, 36, 44 and 56 respectively. However, the combination of Lunsford et al. and Kubo et al. do not disclose the method wherein the network-based communication service is an automated communication service that does not require voice commands.

In the same field of endeavor, Holt et al. disclose the method wherein the network-based communication service is an automated communication service that does not require voice commands ([0060] to [0061]).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the personal information device of the combination of Lunsford et al. and Kubo et al. by specifically including the network-based communication service is an automated communication service that does not require voice commands, as taught by Holt et al., the motivation being in order to reduce network costs and can make a speech-recognition and control in communication networks more affordable. Additionally, there is another advantage that the loss of power or receipt of a physical impact of a mobile station contemplated by the present invention does not risk the loss of data as with conventional mobile stations. Moreover, the purchase of a new mobile station does not require the user to reprogram data as with conventional mobile stations.

6. Claims 6-7 and 62-63 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lunsford et al. (Pub. No: 2002/0065041) in view of Kubo et al. (Pub. No: 20040067784) and

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further in view of Holt et al. (Pub. No: 20050113074) and further in view of Cheung (Pub. No: 2004/0024647).

Regarding claims 6 and 62, the combination of Lunsford et al. and Kubo et al. and Holt et al. disclose all the limitation in claims 5 and 56 respectively. However, the combination of Lunsford et al. and Kubo et al. do not disclose the method wherein accessing the automated communication service results in an automatic playing of a prerecorded message.

In the same field of endeavor, Cheung discloses the method wherein accessing the automated communication service results in an automatic playing of a prerecorded message ([0044]).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the personal information device of the combination of Lunsford et al. and Kubo et al. by specifically including accessing the automated communication service results in an automatic playing of a prerecorded message, as taught by Cheung, the motivation being in order to notify a customer of the occurrence of an event.

Regarding claims 7 and 63, the combination of Lunsford et al. and Kubo et al. disclose all the limitation in claims 5 and 56 respectively. However, the combination of Lunsford et al. and Kubo et al. do not disclose the method wherein accessing the automated communication service results in an automatic registering of a vote.

In the same field of endeavor, Cheung discloses the method wherein accessing the automated communication service results in an automatic registering of a vote ([0044]).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the personal information device of the combination of Lunsford et al. and Kubo et al. by specifically including accessing the automated communication service results in an automatic registering of a vote, as taught by Cheung, the motivation being in order to notify a customer of the occurrence of an event.

7. Claims 20 and 32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lunsford et al. (Pub. No: 2002/0065041) in view of Kubo et al. (Pub. No: 20040067784) and further in view of Kumar et al. (Pub. No: 2003/0081758).

Regarding claims 20 and 32, the combination of Lunsford et al. and Kubo et al. disclose all the limitations in claims 1 and 29 respectively. However, the combination of Lunsford et al. and Kubo et al. do not disclose the method wherein the transmitting of the dialing signal occurs over a wired connection with the mobile communication device.

In the same field of endeavor, Kumar et al. disclose the method wherein the transmitting of the dialing signal occurs over a wired connection with the mobile communication device ([0021] to [0022]).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the personal information device of the combination of Lunsford et al. and Kubo et al. by specifically including the transmitting of the dialing signal occurs over a wired connection with the mobile communication device, as taught by Kumar et al., the motivation being in order to enable personal digital assistant to quickly and accurately transmit stored telephone numbers directly to other communication device containing a dialing device.

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*Conclusion*

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dai A Phuong whose telephone number is 571-272-7896. The examiner can normally be reached on Monday to Friday, 9:00 A.M. to 5:00 P.M..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nguyen Duc can be reached on 571-272-7503. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Dai Phuong

AU: 2617

Date: 05/25/2007



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